

### **III. Remarks**

#### **Co-Pending Applications**

In response to the Examiner's request, Applicants believe that the following related applications are pending before the USPTO:

- 1) Application No. 11/785,757, with Art Unit 3774, Examiner: Paul Prebilic;
- 2) Application No. 11/042,546, with Art Unit 3774, Examiner: Paul Prebilic; and
- 3) Application No. 10/182,352, with Art Unit 3733, Examiner: Mary Hoffman.

The image file wrapper for each of the aforementioned applications is available on the USPTO's Patent Application Information Retrieval (PAIR) system.

#### **Claim Status**

Claims 1, 2, 4-8, 10-21, and 23-35, 37, and 39-42 are pending. Independent claim 1 has been amended to incorporate subject matter similar to that of previously examined claims 36 and 38. Support for the claim amendments is found, for example, in original claims 36, 38, Figs. 1C-1G, and the text related thereto. Dependent claims 37 and 39-42 have been amended to maintain the structure of the claims, and, therefore, these amendments do not require further consideration or search and should be entered. Claims 36 and 38 have been canceled.

#### **Rejections under 35 U.S.C. § 102**

Independent claim 1 stands rejected under § 102(b) as being anticipated by U.S. Patent No. 5,059,193 to Kuslich et al. ("Kuslich"). With respect to the claim as herein amended, the rejection is respectfully traversed.

The PTO provides in MPEP § 2131 that "[t]o anticipate a claim, the reference must teach every element of the claim." Therefore, with respect to amended claim 1, to support a rejection under 35 U.S.C. § 102(b), the Kuslich reference must contain all of the elements of the claim.

Amended claim 1 requires, in part:

a pliable tube ... wherein ... when deformed to the second configuration, a plurality of axially displaced leaves extend from said tube to define said second configuration, wherein adjacent leaves touch each other in said second configuration.

The second configuration of Kuslich is illustrated in Fig. 1 and shows only radially arranged ribs that are separated, not touching, to create a “rigid ball-like structure.” Accordingly, Kuslich fails to teach every element of amended claim 1 as required by MPEP § 2131. For these reasons, applicants respectfully submit that claim 1 as amended is not anticipated by Kuslich.

### **Rejections under 35 U.S.C. § 103**

Independent claim 1 and dependent claims 36 and 38, *inter alia*, stand rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,707,390 to Bonutti (“Bonutti”). Claim 1 has been amended to incorporate limitations similar to previously examined and now cancelled claims 36 and 38. The Examiner did not establish a *prima facie* case or provide any explanation regarding the obviousness of claims 36 and 38 in view of Bonutti. Applicants traverse this rejection on the grounds that this reference is defective in establishing a *prima facie* case of obviousness with respect to the now amended claim 1.

MPEP § 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In the present matter, amended claim 1 requires, in part:

a pliable tube ... wherein ... when deformed to the second configuration, a plurality of axially displaced leaves extend from said tube to define said second configuration, wherein adjacent leaves touch each other in said second configuration.

Bonutti shows only radially arranged arms that are separated and not touching each other. Thus, for at least this reason, applicants submit that the examiner’s burden of factually supporting a *prima facie* case of obviousness has not been met, and the rejection under 35 U.S.C. § 103 should be withdrawn.


### **Dependent Claims**

Claims 2, 4-8, 10-21, 23-35, 37, and 39-42 depend from and further limit claim 1. For the reasons above, applicants submit that the dependent claims are patentable over the prior art.

**IV. Conclusion**

Reconsideration of this application in light of the above amendments and remarks is respectfully requested. Should the Examiner deem that an interview would expedite consideration or prosecution of the application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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